

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and following remarks is respectfully requested.

Claims 8-9, 12 and 14 are pending in this application. By this amendment, Claims 8, 12 and 14 are amended; Claim 10 is cancelled; and no claims are added herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 8-10, 12 and 14 were rejected under 35 U.S.C. § 112, first paragraph; Claim 10 was rejected under 35 U.S.C. § 112, second paragraph; Claims 8-10, 12 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,983,524 to Polegato in view Applicants' admitted prior art (AAPA).

With respect to the rejections under 35 U.S.C. § 112, first and second paragraphs, Claims 8, 12 and 14 are amended and Claim 10 is cancelled. Withdrawal of the § 112 rejections is respectfully requested.

With respect to the rejection of the claims under 35 U.S.C. § 103(a) as unpatentable over Polegato in view of AAPA, it is submitted that the applied art does not teach or suggest the claimed features. In particular, the applied art does not teach the feature of a border which is monolithic with the tread. As shown in Fig. 1 of the present invention for example, the border 17 extends over the midsole and is joined perimetricaly and hermetically to the midsole thereby creating a seal which is located over the membrane. The production of the tread together with the border as a single piece, allows for reduction in production times, thus increasing the productivity. Moreover, it requires the use of only one mold, thus reducing the production costs. The applied art does not teach the features of the claimed invention and therefore, cannot provide at least the advantages discussed above.

None of the embodiments of Polegato discuss a border as claimed. As shown in Fig. 9 of Polegato, there is no border that extends over the filler layer 518. Further, Polegato does

not disclose a seal which is above a membrane as there are no borders positioned over the membrane. Instead, Polegato discloses obtaining a seal below the membrane, where the seal is obtained with the tread at a position below the membrane.

A seal from above the membrane as set forth in the claimed invention provides the advantage of directly attaining a ‘sandwich’ midsole including the membrane and the protective layer, in a single cutting operation, for example from a laminated material. This is because both the protective layer and the membrane are of the same dimensions. To the contrary, the midsole of Polegato is comprised of either (i) a protective layer which is perimetricaly smaller than the membrane or (ii) a protective layer which is perimetricaly thinner than the membrane. This is required in order to effect the aforementioned sealing from below the membrane to the tread, either around the protective layer or through the thin regions of the protective layer. In either of the cases, the protected layer must be cut separately from the membrane and later assembled together to form a ‘sandwich’ layer. Further, prior to forming such a layer the protective layer must be positioned precisely onto the membrane in order to align the borders of the protective layer with the border of the membrane.

Independent Claims 8, 12 and 14 further recite in part, the feature of a thermoreactive adhesive. The Office Action asserts that it is obvious to use an already known thermoreactive adhesive in order to provide stronger bond between the protective layer and the membrane of Polegato. The Office Action further asserts that the present invention only teaches substituting the adhesive of Polegato with a better adhesive. Applicants disagree. Specifically, one or more embodiments of the invention do not simply teach using a better adhesive but using a temperature resistant adhesive. Thermoreactive adhesives are used in order to provide a coupling between the membrane and the respective protective layer which is resistant to high temperatures. A main characteristic of a thermoreactive adhesive is that of

having a structure that is thermally irreversible so that when subjected to high temperatures, such as during molding, the adhesive does not revert to their fluid condition. The resistance to the temperature is not a characteristic common to all kinds of adhesives, even of those adhesives having the same bonding force. Applicants submit that an adhesive capacity is an intrinsic characteristic of an adhesive, however, the temperature resistant characteristic is not obtained from simply any adhesive.

The Office Action supports the above assertion based on the following passage from the description of the present invention: “*These adhesive, due to the temperature, produce many intermolecular bonds (between molecule), thus forming a three-dimensional structure that is partially rigid and in any case thermally irreversible.*” Applicants respectfully submit that this passage does not provide any basis to justify the argument that the bond must be stronger. That is, the passage relates to bonds between the molecules and not a bond between the layers of material through the adhesive or even a bond between the adhesive and the layers. Specifically, the term “*intermolecular bonds*” refers to the thermoreactive adhesive intrinsically and which forms a three dimension structure and are thermally irreversible. The term does not refer to a structure formed between the protective layer and the membrane. The adhesive capacity of the thermoreactive adhesive does not have to be stronger. In fact the thermoreactive adhesive of one or more examples of the present invention may be just as strong as the adhesive of Polegato. Accordingly, the discussions of Polegato do not render obvious teaching of the present invention as there is no disclosure of a thermally irreversible adhesive.

Polegato merely discusses that a membrane 15 and lower protective layer 16 are coupled to one another by spot gluing, using a commercially available adhesive that is resistant to hydrolysis. AAPA is discussed with respect to adhesives that are used to produce barrier fabrics for surgical uses. Applicants submit that the medical field is far from the field

of manufacturing soles for shoes and a person of ordinary skill in the art would not look to the medical field to solve a problem with respect to shoe soles. As such, Applicants submit that a person skilled in the art would not have been motivated to combine Polegato and AAPA.

Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) as unpatentable over Polegato in view of AAPA is respectfully requested.

Consequently, for the reasons discussed in detail above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

Respectfully submitted,

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